

Applicant: Hage
Serial No.: 10/635,812
Group Art Unit: 1714

PATENT
Docket No.: 110000-9410

REMARKS/ARGUMENTS

This amendment is filed in response to the Office Action mailed November 18, 2005. In this Amendment, claims 1 and 14 are amended. Following entry of this amendment, claims 1-16 shall be pending.

In the Final Office Action, claims 1-16 have been rejected based on various prior art grounds. The applicant hereby requests reconsideration of these claims in view of the amendments and reasons set forth below.

For the reasons previously submitted to the Examiner, the Applicant does not concede to the continued assertion of the various references against the invention and, hence, the Applicant incorporates by reference these very same arguments into this response. However, in this response, the Applicant provides yet further arguments as to the patentability of the presently claimed invention.

I. REJECTIONS UNDER 35 USC § 112, FIRST PARAGRAPH

Claims 1-16 were rejected under 35 USC § 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner has asserted that, in making Applicant's amendment to claims 1 and 14 to recite that the ink is "both removable and opaque," that "Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed."

Applicant respectfully takes this opportunity to point out multiple areas of the specification that fully support the earlier-proposed amendments to claims 1 and 14. First, with regards to opacity, at least at paragraph [0024], Applicant points out that, among the coloring agents proposed for use in the present invention, "titanium oxide is specially preferred by virtue of the brightness, whiteness, opacity..." Further, that "other colors may be used for trade names, company names, trademarks, logos, and other forms of branding." Also, at paragraph [0011], one purpose of marking a lens with ink contemplated in the present invention is recited as including "any image and any character as well as any identifying indicia such as a trademark or logo." Additionally, at

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paragraph [0002], it is disclosed that "ink is useful for various purposes, including but not limited to, making such things as progressive markings, identifying axis of polarization, designating the cylinder axis, and marking with a brand name, trademark or logo."

Opacity of ink is therefore mentioned or inherently suggested throughout the specification. Further, the "marking" aspects described in detail above clearly provide support that one skilled in the art would expect that the ink of the present invention is opaque. It would be clear to one skilled in the relevant art that any detailed marking on an ophthalmic lens, such as trademark, logo or other "character," such as letters, words or phrases, must be sufficiently opaque, especially in reference to a clear lens, in order to be visually perceivable. Therefore, the specification provides sufficient information to reasonably convey to one skilled in the art that the ink claimed in the present invention would be, and in fact is, opaque.

Second, with regards to removability, the specification makes several references to the claimed ink being removable. For example, paragraphs [0004] and [0006] repeatedly describe the desirability of a removable ink. Specifically, paragraph [0004] describes problems (such as ghost images) historically found with solventborne inks used in the ophthalmic lens industry, stating that "the ghost image results from the inability to completely remove the solventborne ink because the ink has penetrated the lens, becoming absorbed and embedded due to the strong solvents that are present in the ink." Further, "in addition, some solventborne inks...are very difficult to remove by means that are acceptable to the surfacing laboratories or other customers of ophthalmic lenses who put the lenses into spectacle frames or otherwise prepare the lenses for the wearer." Paragraph [0006] states that "there is a need for an ophthalmic lens marking ink that will provide an adequate level of adhesion for lens handling, yet be easy enough to remove..." Additionally, at paragraph [0042], as Examiner has pointed out, describes an ink that "is removable by 2-propanol or aqueous anionic detergent."

Removability of ink is therefore expressly mentioned at least several times in the specification, and it is clear that one skilled in the art, specifically the ophthalmic lens

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industry, would realize that the intent of the present invention is to provide an ophthalmic lens marking ink that is removable or non-permanent.

While Examiner agrees that paragraph [0042] recites that "the ink is removable by 2-propanol or aqueous anionic detergent," he further states that "there is no support to broadly recite that the ink is removable which encompasses all means," and thus is not "commensurately enabling" to prevent undue experimentation in order to "practice and use applicant's invention." Examiner asserts that undue experimentation would be necessary, because no direction or guidance has been presented and there is an absence of working examples, resulting in claims 1-16 reading on ink that is removable by any type of removal means such as water, non-aqueous solution, cationic detergent, by scrapping or rubbing, etc.

Applicant submits that one skilled in the art would realize that a waterborne ink is, by definition, primarily reduced with water instead of solvent, and thus would be easily removable by means such as water, detergent, solvent or any useful combination thereof. In this regard, Applicant has gone so far as to provide specific examples of such removal means, namely use of 2-propanol (a solvent) or anionic detergent (a strong detergent). Applicant is not required to provide all conceivable examples of removal, beyond that which was provided and which would already be well-known by one of skill in the relevant art. Applicant has also amended claims to further clarify that the present invention is directed to an ink that remains removable, not just a permanent ink that may be removed by blotting the ink before it has dried. At least for these reasons, withdrawal of all rejections under §112 is respectfully requested.

II. REJECTIONS UNDER 35 USC § 112, SECOND PARAGRAPH

Claims 1-16 are further rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has above indicated support in the specification sufficient to particularly point out the subject matter under which claims 1 and 14 were amended, and for which Applicant regards as the invention. Applicant has described above how the ink may be removed. Applicant asserts that "when" the ink is

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removable is at least adequately described in paragraph [0006] of the specification, which reads "...yet be easy to remove after the lenses are edged for a given spectacle frame..." Also, paragraph [0042] indicates that the ink is removable after an ink image is printed on the lens. One of ordinary skill of the art would be adequately informed by at least these examples in the specification as to when the ink is removable.

At least for these reasons, withdrawal of all rejections under §112 is respectfully requested.

III. REJECTIONS UNDER 35 USC § 102(e)

At paragraph 8 of the Office Action, claims 1, 9-10 and 13-16 were rejected under 35 USC §102(e) as being anticipated by *Doshi* (U.S. 6,315,410). As was argued in response to the previous office action, *Doshi* relates to a permanent dye for contact lenses and does not disclose a non-permanent ophthalmic ink as recited in the claimed invention. The *Doshi* reference discloses an ink that is intended for permanency, namely contact lens coloration. Specifically, at least at column 24, lines 34-38, *Doshi* reads "In particular, the composition of matter of the present invention are preferably water resistant after polymerization such that pigments in the ink substantially stay where they have been deposited by printing processes." The present invention most certainly does not claim a water-resistant ink, since it clearly provides methods of removing the ink which include water. Further, at column 24, lines 41-44, *Doshi* reads "the inks of the present invention are preferably capable of chemically bonding, cross-linking or otherwise binding with polymers or monomers on the surface being printed." Based on these assertions in *Doshi*, it is clear that the ink is intended to be permanently imparted to a contact lens, and thus does not anticipate a non-permanent ink as in the claimed invention.

Further, one of ordinary skill in the art would realize that ink is imparted to a contact lens, as disclosed in *Doshi*, typically for at least the following reasons: one, ink is imparted for purposes of permanently, artificially coloring a portion of a contact lens sufficient to color a lens wearer's iris and two, color is imparted to a contact lens for purposes of permanently tinting the lens so that it will be easily locatable outside of lens

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wearer's eye (for example, if a contact lens is dropped, it will be identifiable by the tint, where it would otherwise be clear and undetectable). Specifically, at column 22, lines 33-35, *Doshi* discloses digitally encoding an image comprising "at least a portion of an image, such as...the iris of an eye." It is clear that, in either scenario, permanent coloration or marking of the lens is intended, and thus, one of ordinary skill in the contact lens art would find no credible basis for which the *Doshi* reference would anticipate a non-permanent ink, as presently claimed.

The Examiner has indicated that col. 11, lines 14-15 and 50-51 of *Doshi* discloses an opaque ink that is further removable, as indicated at col. 21, 38-40. Applicant respectfully asserts that this disclosure in *Doshi* only confirms that it does not disclose a removable, non-permanent ink. The only methods of removal suggested in *Doshi* pertain to means of a removing permanently imparted ink, namely blotting scraping or machining. Blotting is a technique that removes excess ink before the ink has dried. Scraping and machining are techniques for removing lens material that has been permanently stained with ink. As such, the visual effects of the ink are removed by physically removing the tinted lens material from the base lens. However, ink is not separated or removed from the material itself. Therefore, non-permanency as recited in the claimed invention is not anticipated by *Doshi*.

Amended claims 1 and 14 are therefore allowable. Claims 9-10 and 13 depend from allowable claim 1 and are therefore also allowable for at least the same reasons. Furthermore, these dependent claims further define and describe the present invention and thus are patentable over and above the claims 1. As such, withdrawal of this rejection is respectfully requested.

At paragraph 9 of the Office Action, claims 1 and 9-16 were also rejected under 35 USC §102(e) as being anticipated by *Doshi et al.* (U.S. 2004/0130676). *Doshi et al.* also relates to a permanent dye for contact lenses and, therefore, does not disclose a non-permanent ophthalmic ink as claimed in the present invention. The *Doshi et al.* reference discloses an ink that is intended for permanency, namely permanent contact lens tinting/coloration. Regarding Examiner's assertion that removability of ink is

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suggested at paragraph 198 of the *Doshi et al.* reference, this disclosure only confirms that *Doshi et al.* does not disclose any means of removing a non-permanent ink. That *Doshi et al.* pertains only to a permanent ink is made clear at paragraph [0220] of *Doshi et al.*, which provides that "the inks of the present invention are preferably capable of chemically bonding, cross-linking or otherwise binding with polymers or monomers on the surface being printed." Based on these descriptions in *Doshi et al.*, it is clear that the ink is intended to be permanently imparted to a contact lens, and thus does not anticipate a non-permanent ink as claimed in the present invention.

Amended claims 1 and 14 are therefore allowable. Claims 9-13 depend from allowable claim 1 and claims 15 and 16 depend from allowable claim 14, and are therefore also allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claims 1 and 14.. As such, withdrawal of this rejection is respectfully requested.

At paragraph 10 of the Office Action, claims 1, 10 and 13-16 were rejected under 35 USC §102(e) as being anticipated by *Tucker et al.* (U.S. 2003/0119943). *Tucker et al.* discloses an ink for marking contact lenses, for purposes of imparting permanent color to the entire surface of a contact lens. Claim 1 of the present invention recites a non-permanent ink. Further, the intended permanency of the ink disclosed in *Tucker et al.* is found at least at paragraph [0027], which provides that a finger rubbing test is performed on a lens to ensure that the ink placed on the contact lens is not removed and/or removable. Also, as pointed out by the Examiner, there is no disclosure in *Tucker et al.* that the ink is removable, and thus there is no basis to assert that the ink could be construed as inherently removable.

Amended claims 1 and 14 are therefore allowable. Claims 10 and 13 depend from allowable claim 1 and claims 15 and 16 depend from allowable claim 14, and are therefore also allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claims 1 and 14.. . As such, withdrawal of this rejection is respectfully requested.

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At paragraph 11 of the Office Action, Claims 1-3, 7-9 and 14-16 were rejected under 35 USC 102(e) as being anticipated by *Yamakazi et al.* (U.S. 2002/0017219). The Examiner agrees that there is no disclosure that the ink is an ophthalmic marking ink as presently claimed. Therefore, the *Yamakazi et al.* reference would not anticipate the non-permanent, ophthalmic ink of the presently claimed invention, and the withdrawal of this rejection is respectfully requested.

IV. REJECTIONS UNDER 35 USC §103

At paragraph 13 of the Office Action, Claims 2, 6, and 7-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Doshi*. (U.S. 6,315,410) in view of *Yui et al.* (U.S. 5,948,155). The *Doshi* reference teaches away from the claimed invention, in that the ink in *Doshi* is a permanent ink. The presently claimed invention recites a non-permanent ophthalmic marking ink. One of skill in the art would not look to *Doshi* if faced with the task of developing a non-permanent, opaque ophthalmic ink.

Furthermore, claims 2, 6 and 7-8 depend from allowable claim 1 and are therefore allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claims 1 and 14. As such, withdrawal of this rejection is respectfully requested.

At paragraph 14 of the Office Action, Claims 2, 6, 7-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Tucker et al.* (U.S. 2003/0119943) in view of *Yui et al.* (U.S. 5,948,155). The *Tucker et al.* reference teaches away from the present invention, in that the ink in *Tucker et al.* is a permanent ink. The present invention teaches a non-permanent ophthalmic marking ink. One of skill in the art would not look to *Tucker et al.* if faced with the task of developing a non-permanent, opaque ophthalmic ink as claimed.

Furthermore, claims 2, 6 and 7-8 depend from allowable claim 1 and are therefore allowable for at least the same reasons. However, these claims further define

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and describe the present invention and are patentable over and above claim 1. As such, withdrawal of this rejection is respectfully requested.

At paragraph 15 of the Office Action, Claims 11 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Doshi* (US 6,315,410) or *Tucker et al.* (U.S. 2003/0119943) either of which in view of in view of *Souel et al.* (U.S. 6,281,468). As specified above, both the *Doshi* and *Tucker et al.* references teach away from the present invention, as they both teach a permanent ink. The present invention teaches a non-permanent ophthalmic marking ink. One of skill in the art would not look to *Doshi* or *Tucker et al.* if faced with the task of developing a non-permanent, opaque ophthalmic ink as claimed.

Furthermore, claims 11 and 12 depend from allowable claim 1 and are therefore allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claim 1. As such, withdrawal of this rejection is respectfully requested.

At paragraph 16 of the Office Action, Claims 4-5 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Yamakazi et al.* (U.S. 2002/0017219) in view of *Valentini et al.* (2003/0184629). *Yamakazi et al.* teaches away from a non-permanent marking ink for use with an ophthalmic lens. All examples provided in the *Yamakazi et al.* reference refer to ink printing on paper. Further, *Yamakazi et al.* teaches a permanent ink that reduces the problem of malalignment of a deposited ink by providing a component for preventing ink clogging within the ink jet head (paragraph [0039] of *Yamakazi et al.*). This quality is irrelevant to the presently claimed invention. Thus, one of skill in the art would not look to *Yamakazi et al.* if faced with the task of developing a temporary, opaque ophthalmic ink.

Furthermore, claims 4 and 5 depend from allowable claim 1 and are therefore allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claim 1. For at least these reasons, withdrawal of this rejection is respectfully requested.

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CONCLUSION

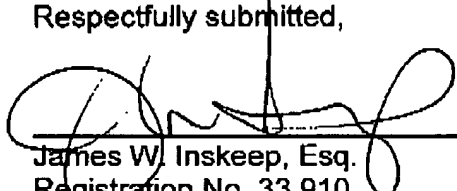
In view of the foregoing, it is demonstrated that none of the prior art cited anticipates or renders obvious, alone or in combination, currently pending claims 1-16. Thus, it is respectfully requested that the Examiner withdraw all of the rejections and issue a notice of allowance of all claims.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: May 17, 2006


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